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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KANJI KIRIMOTO, TSUYOSHI SAKASHITA
and KAZUHISA YAMASHITA

Appeal 2009-002559
Application 10/826,173
to reissue Patent 6,557,671
Technology Center 3600

Decided: August 17, 2009

Before: ALLEN R. MacDONALD, *Vice Chief Administrative Patent Judge*, FRED E. McKELVEY, *Senior Administrative Patent Judge*, and HOWARD B. BLANKENSHIP, *Administrative Patent Judge*.

McKELVEY, *Senior Administrative Patent Judge*.

DECISION ON APPEAL

A. Statement of the case

The application on appeal was filed on 19 April 2004 to reissue U.S. Patent 6,557,671 B1.

Shimano, Inc. ("Shimano"), the real party in interest, seeks review under 35 U.S.C. § 134(a) of a final rejection (mailed 28 September 2007).

(1) Claims 37-43, 47-54 and 69-74 are rejected as being unpatentable under 35 U.S.C. § 103 over:

(i) Carre, U.S. Patent 4,582,177,

(ii) Le Deit, U.S. Patent 5,697,475, and

(iii) Huang, U.S. Patent 6,148,964.

(2) Claims 55-59 are rejected as being unpatentable under 35 U.S.C. § 103 over:

(i) Carre,

(ii) Le Deit,

(iii) Isai, U.S. Patent 5,960,914, and

(iv) Huang.

(3) Claim 60 is rejected as being unpatentable over:

(i) Carre,

(ii) Mott, U.S. Patent 5,201,402,

(iii) Le Diet,

(iv) Isai, and

(v) Huang.

Le Deit, Carre and Mott are prior art under 35 U.S.C. § 102(b).

Isai is prior art under 35 U.S.C. § 102(a).

Huang is prior art under 35 U.S.C. § 102(e).

Shimano does not attempt to antedate (37 C.F.R. § 1.131) Isai or Huang.

We discuss the prior art rejections in Part C.

(4) Claims 37-60 and 69-74 are rejected as being unpatentable based on the "recapture" rule.

We discuss the recapture rule rejection in Part D.

Claims 1-36, 61, 63-65 and 67-68 have been allowed.

See Appendix 1 at the end of this opinion for a visual summary of the rejected and allowed claims.

Claim 54

In the final rejection and the Examiner's Answer, claim 54 is not included in the list of claims rejected over Le Deit, Carre and Huang.

Nevertheless, the Examiner discusses why claim 54 is not patentable over the prior art.

In the Appeal Brief, Shimano treats claim 54 as rejected over Le Deit, Carre and Huang. Appeal Brief, pages 7 and 13.

Upon a consideration of the record, as a whole, we find that

(1) claim 54 was rejected over Le Deit, Carre and Huang and

(2) while Shimano does not single out claim 54 for separate consideration, Shimano nevertheless contests the rejection of claim 54—along with other claims—on appeal.

We have jurisdiction under 35 U.S.C. § 134(a).

B. Findings of fact

The following findings of fact are believed to be supported by a preponderance of the evidence.

References to the specification are to U.S. Patent 6,557,671 B1.

To the extent that a finding of fact is a conclusion of law, it may be treated as such. Additional findings as necessary may appear in the Discussion portion of the opinion.

The invention

The invention of claim 37 can be understood by reference to (1) Figs. 1, 2, 4, 5, 6, 7 and 44, all reproduced below, and (2) associated parts of the specification.

Elements mentioned in claim 37 are also described after reproduction of the drawing Figs.

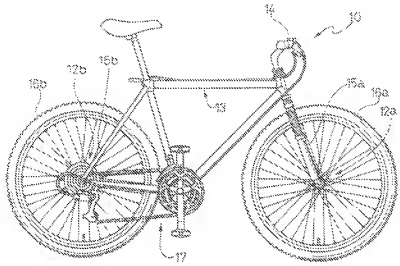


FIG. 1

Fig. 1 depicts a side elevation view of a bicycle with a pair disk brakes 12a and 12b

12a is a front wheel cable disc brake. 12b is the back wheel disc brake.

16a is a front bicycle wheel.

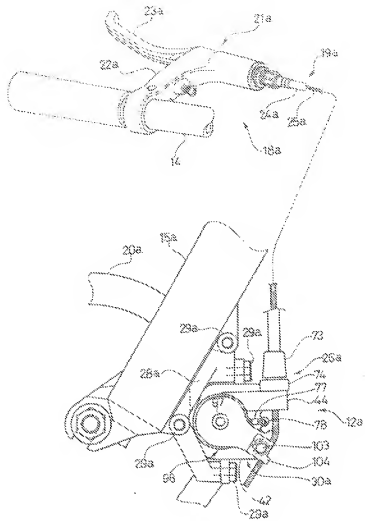


FIG. 2

Fig. 2 depicts a side elevational view of a front portion of a bicycle with a front cable disc brake

12a is a front wheel disc brake.

20a is a disc brake rotor (see also the unnumbered curved element right above "FIG. 2").

25a is a cable.

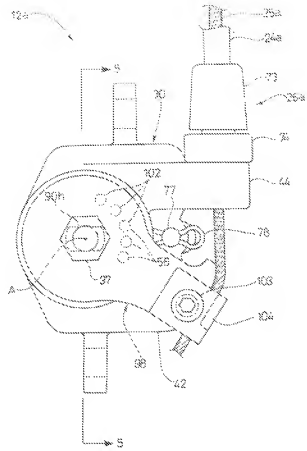


FIG. 4

Fig 4 depicts a partial side elevational view of the front cable disc brake

12a is a disc brake.

25a is a cable.

44 is a cable support.

98 is an elongated actuating arm (see also Fig. 7).

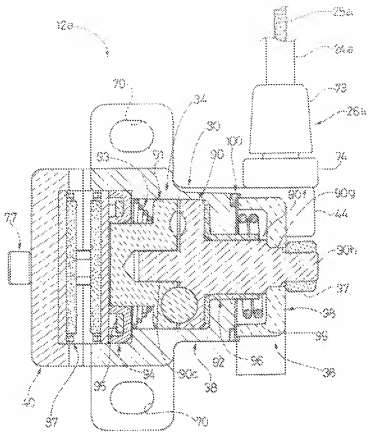


FIG. 5

Fig. 5 depicts a longitudinal cross-sectional view of the front cable disc brake

12a is a disc brake.

30 is a caliper housing.

44 is a cable support.

98 is an elongated actuating arm (see also Fig. 7).

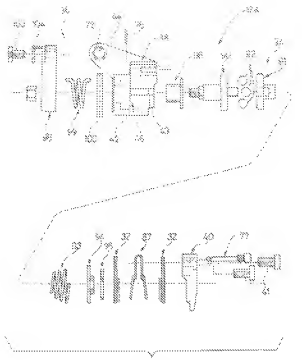


FIG. 6

Fig. 6 depicts an exploded elevational view of a front cable disc brake

32 (left and right) are first and second friction members.

34 is a cam assembly.

36 is an actuating assembly (i.e., actuating mechanism).

The cam assembly and actuating assembly together form a cable actuated mechanism that moves the brake pads between a release position and braking position. Col. 6:16-19.

72 is an opening.

103 is a cable clamping bolt.

104 is a cable clamping plate.

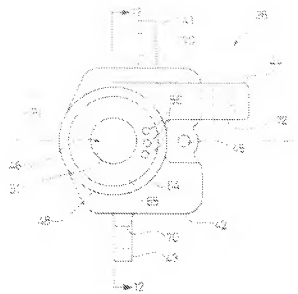


FIG. 7

Fig. 7 depicts a front elevational view of a left caliper portion of a front cable disc brake

42 is a body portion.

43 is a mounting bracket.

44 is a cable support.

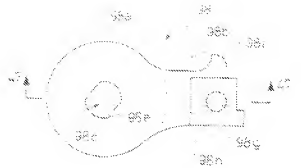


FIG 44

Fig. 44 depicts an end elevational view of
an actuating arm for a front cable disc brake

98 is an actuating arm.

98i is a curved guide surface.

Rejected claim 37 reads as follows [bracketed material, drawing Figs. and element numbers and references to specification added]:

A cable disc brake [Figs. 1 and 5, 12a; col. 6:13-16] for a bicycle comprising:

[1] a caliper housing [Fig. 5, 30; col. 6:13-16] with a mounting bracket [Fig. 7, 43; col. 6:41-43] structured and dimensioned to be attached to a bicycle [as shown in Fig. 2] and with a cable support [Figs. 5 and 7, 44; col. 6:41-43] having an opening (Fig. 7, 72; col. 7:37-39) for guiding a cable [Figs. 2 and 5, 25a; col. 5:55-62 and col. 10:34-37] therethrough;

[2] wherein the cable support 44 extends from a surface of the caliper housing 30 [at body portion 42 as shown in Fig. 7] and is not adjustable in any direction relative to the surface of the caliper

housing [because, for example, body portion 42 and cable support 44 are one piece as shown in Fig. 7 and described at col. 6:41-43];

[3] a first friction member [left side 32, Fig. 6; col. 6:13-16] coupled to the caliper housing 30 for movement between a release position and a braking position [col. 6:21-24];

[4] a second friction member [right side 32, Fig. 6; col. 6:13-16] coupled to the caliper housing 30 and arranged substantially parallel to the first friction member 32 to form a rotor receiving slot therebetween [Fig. 5; col. 6:24-29]; and

[5] an actuated mechanism [34, 36, Fig. 5; col. 6:16-19] movably coupled to the caliper housing 30 to move the first friction member 32 in an axial direction from the release position towards the second friction member 32 to the braking position (col. 6:16-19);

[6] wherein the actuated mechanism 34, 36 comprises an elongated actuating arm [98, Figs. 5 and 44; col. 10:17-22] rotatably coupled to the caliper housing 30 to cause the actuated mechanism 34, 36 to move the first friction member 32 from the release position towards the braking position (col. 11:12-30);

[7] wherein the actuating arm 98 has a curved guide surface [98i, Fig. 44] with a first portion coincident with a cable clamp [103 (clamping bolt), 104 (clamping plate), Fig. 4; col. 10:34-37] and a second portion [curved tip, Fig. 4, unnumbered] that extends from the first portion towards the cable support 44 so that the cable 25a, when coupled to the cable clamp 103, 104, approaches the guide surface 98i from the opening 72 in the cable support 44 essentially tangent to the

guide surface 98i and is supported by the guide surface 98i when the first friction member 32 is in the release position [shown in Figs. 2 and 4].

C. Prior art rejections

Claims 37-43, 47-60 and 69-74 stand rejected under 35 U.S.C. § 103 over the prior art.

To resolve the appeal, we focus solely on the arguments made by Shimano in the Appeal Brief and Reply Brief. All other arguments not made are waived.

Claim 37

Shimano has one argument with respect to the Examiner's § 103 rejection of claim 37.

Shimano calls our attention to the following limitation in claim 37 [comments in brackets, italics and drawing numerals added]:

> wherein the cable support 44 extends from a surface of the caliper housing 30 [at body portion 42 shown in Fig. 7] and is *not adjustable* in any direction relative to the surface of the caliper housing [because, for example, body portion 42 and cable support 44 are one piece as shown in Fig. 7 and described at col. 6:41.43].

Appeal Brief, page 13; Response to Request for Additional Briefing, page 7.

According to Shimano, Le Deit does not describe the noted limitation and therefore the § 103 rejection of claim 37 over the prior art is erroneous.

The Examiner found that the position of cable support 44 of Le Diet, as illustrated in Fig. 6 (characterized as alternative embodiments to those

shown in Figs. 1-5) is not adjustable, or adjustable in any direction. Examiner's Answer, page 16.

The reader should know that, as a mere coincidence, both Shimano and Le Deit label the cable support as 44.

The Examiner goes on to explain that index elements, or bump formulations, 68' and 70', restrict the cable support 44 to a single position with respect to caliper housing 46. The Examiner goes on to say that therefore the cable support cannot be adjusted to any other position with respect to the cable housing. Examiner's Answer, page 16.

In particular, the Examiner calls attention to Fig. 6 and col. 5:9-47.

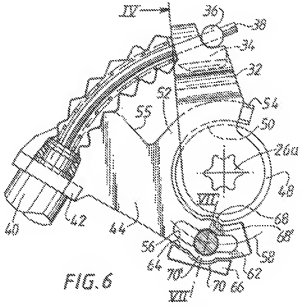


FIG. 6

Fig. 6 depicts a Le Deit alternative actuating device embodiment

Shimano refers to Le Deit Fig. 7, which is reproduced below.

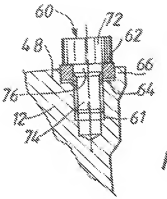


FIG.7

Fig. 7 depicts a section on VII-VII of Fig. 6

The portion of Le Deit relied upon by the Examiner notes the following [bracketed matter and italics added] (col. 5:9-52):

> [A] concave radial depression 68 is formed in the wall of the groove 64 formed by the cylindrical boss 48, the center of this depression 68 being situated substantially on a radius joining the axis X—X' to the axis of the tapped bore 61.
>
> Likewise, a concave radial depression 70 is formed in the wall of the groove 64 formed by the projecting part 66 of the caliper 12, the center of this depression 70 being situated substantially on a radius joining the axis X—X' to the axis of the tapped bore 61, so that the two depressions 68 and 70 face each other on each side of the axis of the tapped hole 61 [Fig. 7].
>
> Finally, the screw 60 [Fig. 7] includes, between its operating head 72 and its threaded shank 74, an intermediate part 76 of axial length substantially equal to the thickness of the bracing piece 44, and the cross-section of which adopts a cam

shape, the largest diameter of which is greater than the initial width of the oblong slot 56.

When the brake is being set in the way which has already been explained, once the tab 54 is bearing on the lever 32, the initial effect of tightening the screw 60 in the bore 61 is to hold it radially in the caliper 12 [Fig. 1—not reproduced].

Then, as the screw 60 is tightened further, the intermediate part 76 is brought into the vicinity of the edge of the oblong slot 56. The cam-shaped cross-section of the intermediate part 76 then deforms the walls of the slot 56, which deformation is passed on to the material of the arm 62, the depress then expand into the depressions 68 and 70, therein forming bumps 68' and 70' respectively. *The bracing piece 44 is thus in its optimum position as defined above.*

In contrast, *if the screw 60 is taken out following an incorrect operation, the bracing piece 44 is no longer held and can then escape.* It will then be very easy to put it back in place, and what is more, to put it back in place in its initial and optimum setting position. In fact, *it will have been understood that the only possible angular position for the bracing piece 44 on the caliper 12 is the one in which the bumps 68' and 70' are put back in place in the depressions 68 and 70.*

All that will then be required will be to put the bracing piece 44 back into this position, then to retighten the screw 60, or even some other screw which does not have the intermediate

cam-shaped part 76, in order to regain the disk brake with its optimum initial setting.

Shimano urges that the Le Deit cable support is "adjustable" whereas claim 37 requires that the cable support "is not adjustable." The Examiner found otherwise. Shimano has not convinced us that the Le Deit cable support is adjustable. In fact, based on Le Deit Fig. 6 and the accompanying discussion, it would appear that the cable support, once in place, is intended to remain in place. No further adjustment is needed or would be contemplated.

Shimano cites and relies on *Dorel Juvenile Group, Inc. v. Graco Children's Products, Inc.*, 429 F.3d 1043 (Fed. Cir. 2005) (two parts screwed together are "removably attached" in the context of the invention involved). The *Dorel* "-able" definition is said to have been adopted in an amendment filed on 9 July 2007. Language in a claim undergoing examination is given its broadest reasonable construction consistent with the specification. *In re Prater*, 56 CCPA 1381, 1396, 415 F.2d 1393, 1404 (CCPA 1969). We fail to see how the invention described in the patent involved in the *Dorel* opinion has anything to do with Shimano's invention.

The word "adjustable" is not found in the specification of the Shimano patent—or at least we could not find it. Because body portion 42 [Shimano Fig. 7] and cable support 44 are characterized as being one piece, Shimano reasons they are not adjustable one vis-à-vis the other. What is manifest is that once put together, the Le Deit device is not adjustable within the ordinary meaning of that term. The Fig. 7 Shimano device and the Fig 6. Le Deit device appear to be equally non-adjustable.

According to Shimano, the Le Deit configuration is adjustable. Why? Because, Le Deit screw 60 could be loosened or removed, and then washers or shims could be placed beneath cable support 44 thereby adjustment the position of cable support 44 upwardly from the page. Appeal Brief, page 14. As the Examiner notes, Shimano's possibility is mere speculation. Examiner's Answer, page 16. "[N]one of what the applicant states [, i.e., speculates,] need occur [to construct and use the Le Deit device as described by Le Deit]. *Id.*

The decision of the Examiner rejecting claim 37 under § 103 over the prior art is *affirmed.*

Claim 38

Claim 38 reads (italics added):

> A cable disc brake according to claim 37 [reproduced earlier] wherein the second portion of the guide surface is formed by a projection that forms a circumferentially *elongated protuberance* that points in a rotational direction of the actuating arm towards the cable support where the cable passes through the cable support such that the cable is supported on and by the protuberance.

According to Shimano, neither Le Deit nor Carre nor Huang describe a projection that forms a circumferentially elongated protuberance. Appeal Brief, page 14.

As in the case of the word "adjustable" in claim 37, the word "protuberance" is not to be found in the Shimano specification. As best we

can tell, the word was added to claim 38 sometime after filing of the application which matured into the Shimano patent.

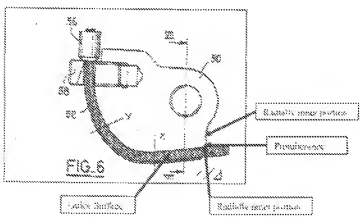
In an amendment filed 26 April 2007, Shimano states (page 19):

> A protuberance is defined for the purpose of the claim as a structure that bulges out beyond the surrounding surface.

While a patent applicant may act as its own lexicographer, the place to do so is in the specification, as filed—not as an afterthought in an amendment filed after the application is filed.

We would add that we do not believe the word "elongated" adds much to "protuberance" given the Shimano "definition" of "protuberance." In other words, on this record we would not be able to distinguish "elongated protuberance" from "protuberance."

Taking Shimano at its word, and using its definition of "elongated protuberance," the Examiner found that Fig. 6 of Carre describes the required protuberance. Believing that a picture is worth a thousand words, the Examiner provides the following annotated version of Carre Fig. 6:



Depicted is the Examiner's annotated version of Carre Fig. 6

As the Examiner's annotated version of Carre Fig. 6 reveals, Carre describes the required protuberance.

According to Shimano, no protuberance is shown. Shimano goes on to say:

> At most, the draftsperson inadvertently drew an unevenly thick line as he or she drew the cured portion of the member (50). There is no basis to believe that a protuberance was intended, and certain not an elongated protuberance as recited in claim 38.

Appeal Brief, page 15.

There is no testimony from the "draftsperson." Hence, neither the Examiner nor this panel can determine whether an "unevenly thick line" was or was not inadvertent. Nor can the Examiner or the Board determine what was "intended." Rather, the Examiner and the Board make findings based on the evidence. The factual question here is: "What is described in Fig. 6 of Carre?" Whether inadvertent or not, or intended or not, the plain fact is that Carre Fig. 6 describes a protuberance within the meaning of Shimano's afterthought definition of "protuberance." We cannot say the described protuberance is not elongated because Shimano failed in its specification to define the meaning of elongated. Accordingly, anything that "sticks" out can be fairly said to be a "protuberance" or an "elongated protuberance."

The decision of the Examiner rejecting claim 38 under § 103 is *affirmed*.

Claims 39 and 40

Claim 39 reads:

> A cable disc brake according to claim 38 [reproduced earlier] wherein the projection has a radially outer portion that extends towards the cable support and a radially inner portion that extends away from the cable support back towards a side surface of the actuating arm.

Claim 40 reads:

> A cable disc brake according to claim 39 wherein the projection is disposed in close proximity to a radially outermost portion of the actuating arm.

According to Shimano, the combination of Le Deit, Carre and Huang do not disclose or provide "a motivation" to form the required outer and inner portions of claim 39 or the projection of claim 40. Appeal Brief, page 15. Shimano adds nothing to the "argument" in its Reply Brief. Reply Brief, page 3.

In the Final Rejection (mailed 28 September 2007), the Examiner made the following findings (page 5):

> Carre … teach[es] a cable disc actuating system comprising an actuating arm 50 provided with a curved guide surface with a first portion coincident with a cable clamp 58 and a second portion extending from the first portion, wherein the second portion is a projection defined by a protuberance (see figure 6, note the slight protuberance at the cable exit portion of the arm) that supports the cable (*claim 38*); the projection has a radially

> outer portion (*claim 39*); the projection is disposed at the radially outermost portion of the actuating arm (*claim 40*); the cable, once coupled to the cable clamp, approaches the guide surface from the opening in the cable support in substantially a straight line (*claim 54*, due to the curved guide surface the cable extending from the cable support will extend in a straight line as shown by Carre …). Furthermore, Carre … teach[es] that the curved guide surface structure of the actuation arm provides for an increase in torque exerted during rotation, see column 4, lines 61-64, thereby improving braking response.

The Examiner goes on to explain why it would have been obvious to replace the actuating arm of Le Deit with the actuating arm taught by Carre, "thereby improving the overall brake performance and response of the cable actuated brake mechanism." Final Rejection, page 5.

An appeal brief is supposed to contain the "contentions of appellant with respect to each ground of rejection … and the basis therefore, with citations of the … parts of the record relied on." 37 C.F.R. § 41.37(c)(1)(vii).

What Shimano's Appeal Brief amounts to is an assertion that the Examiner is wrong. Missing from the brief is the "why?" *Compare Ex parte Belinne*, Appeal 2009-004693, slip op. at 6-7 (BPAI Aug. 10, 2009 (informative opinion), available at:

http://www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf

Shimano did not undertake a discussion pointing out why the Examiner's findings are wrong. A skeletal argument, really nothing more

than an assertion, does not preserve a claim for argument on appeal. *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1250 n.2 (Fed. Cir. 2008) ("Judges are not like pigs, hunting for truffles buried in briefs." (quoting *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991))). A brief must present all arguments and cannot ask judges to play archaeologist with a record. *DeSilva v. DiLeonardi*, 181 F.3d 865, 867 (7th Cir. 1999). Shimano, in effect, invites us to "dig" through the record to see if we can find evidence to make out Shimano's case on appeal. We decline the invitation because it is not our role to act as advocate for an appellant. *Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 164 F.3d 110, 112 (2d Cir. 1999).

Since Shimano has not addressed the Examiner's findings and has merely asserted that the Examiner has erred, the decision of the Examiner rejecting claims 39 and 40 under § 103 is *affirmed*.

Claim 43

Claim 43 reads (italics added):

> A cable disc brake according to claim 41 [not reproduced] further comprising an *adjusting mechanism* that adjusts the biasing force applied between the caliper housing and the actuating arm in addition to changes of biasing force caused by rotation of the actuating arm relative to the caliper housing.

Claim 43 was finally rejected under § 103 over the combination of Le Deit, Carre and Huang. Final Rejection, page 4.

However, we have been unable to find any discussion in the Final Rejection addressing claim 43 in particular. Shimano seems to agree and

goes so far as to suggest that claim 43 was not rejected. Appeal Brief, page 15.

Nevertheless, Shimano makes a preemptive strike against any rejection which might be made in the Examiner's Answer. According to Shimano:

> [N]either Le Deit . . . , Carre . . . nor Huang provide a motivation to provide an adjusting mechanism that adjusts the biasing force applied between the caliper housing and the actuating arm in addition to changes of biasing force caused by rotation of the actuating arm relative to the caliper housing.

Appeal Brief, page 15.

In the Examiner's Answer, the Examiner confirms that claim 43 was rejected. Examiner's Answer, page 18.

Responding to Shimano's preemptive strike, the Examiner states:

> With regards to claim 43, turning to figure 6 in Le Deit . . . attention is drawn to a bushing element positioned between a spring end and limit stop 42. The length of this element will determine in part the biasing force applied between the caliper housing and the actuating arm, by either contracting or expanding the rest length of the spring.

Id. Le Deit Fig. 6 is reproduced earlier in this opinion.

In its Reply Brief, Shimano states:

> With regards to claim 43, there is no teaching or reason to modify the length of any bushing in Le Diet . . . to adjust a biasing force of the spring surrounding cable 38.

Reply Brief, page 3.

The argument in the Reply Brief is a new argument. Ordinarily a new argument in a Reply Brief is not considered. However, in this case the Examiner's first exposition of why claim 43 is unpatentable took place in the Examiner's Answer. Under the circumstances, we believe the argument in the Reply Brief should be considered—otherwise Shimano has no opportunity to address the § 103 rejection of claim 43 on the merits.

We understand what the Examiner is saying, but we agree with Shimano that there is no teaching or reason to modify the length of any bushing. To be sure, as the Examiner notes, different size bushings might be used. However, unexplained is why use of different size bushings is "an adjusting mechanism" within the meaning of claim 43.

The decision of the Examiner rejecting claims 43 under § 103 is *reversed.*

Claim 47

Claim 47 reads:

> A cable disc brake according to claim 37 [reproduced earlier] further comprising a cable adjusting bolt fitted within the opening in the cable support through which the cable passes.

In the Final Rejection, the Examiner observed [referring to what we believe is Fig. 2 of Le Deit]:

> Re-claim 47, the opening in the cable support 44 is provided with cable adjusting bolts or elements.

Final Rejection, page 6.

Fig. 2 of Le Deit is reproduced below.

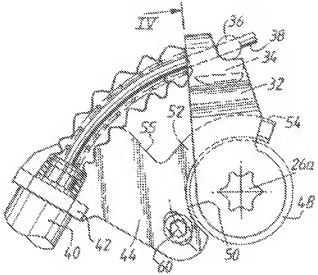


FIG. 2

Depicted is mechanical actuating device
according to the Le Deit invention

According to Shimano, the prior art does not disclose or provide a motivation to include a cable adjusting bolt fitted within the opening in the cable support through which the cable passes. Appeal Brief, page 15.

In the Examiner's Answer, the Examiner appears to shift the basis for the rejection stating:

> With regards to claim 47, Carre . . . clearly teaches a cable adjusting bolt 46, which is clearly capable of being incorporated into the assembly of Le Deit . . . , as this is a common means by which to provide the user a method by which to adjust the cable tension.

Examiner's Answer, page 18.

Carre Fig. 3 is reproduced below.

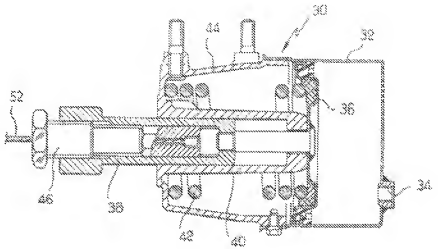


FIG. 3

Depicted is a control jack with a modified output member Shimano's reply to the Examiner's shift in emphasis is:

> With regards to claim 47, Carre . . . neither discloses nor provides a motivation to include a cable adjusting bolt fitted within any opening in any cable support associated with "actuating arm (50)."

Reply Brief, page 3.

Carre describes a cable adjusting bolt 46 fitted within output member 38. Claim 47 requires no more. The Examiner found that the means described by Carre "is a common means by which to provide the user a method by which to adjust the cable tension." Examiner's Answer, page 18. Shimano has not taken issue with the Examiner's finding. Accordingly, we accept the Examiner's finding. *In re Eskild*, 55 CCPA 807, 810, 387 F.2d 987, 988-89 (CCPA 1968) (Examiner's statement relating to common practices in the art was accepted as factual in view of appellant's failure to

challenge the statement). Shimano has failed to establish that the Examiner erred in rejecting claim 47.

The decision of the Examiner rejecting claim 47 under § 103 is *affirmed*.

Claim 69

Claim 69 reads [italics and bracketed matter added]:

> A cable disk [sic—disc] according to claim 37 [reproduced earlier] wherein the cable support [44] is *one piece* with the surface of the caliper housing [30] from which it extends.

In the Final Rejection, the Examiner observed:

> Re-claim 69, the cable support 44 is immobilized (see [Le Deit] column 3 lines 39-43) with respect to the caliper housing 12 and as such is broadly interpreted as being one with the caliper housing.

Final Rejection, page 6.

Le Deit states (col. 3:39-43):

> The oblong slot 56 serves to immobilize the bracing piece 44 on the caliper 12, for example by means of a screw 60 passing through this opening and screwed into a tapped bore made in the rear part 46 of the caliper 12.

Shimano "submit[s] that one piece means one piece. One piece does not mean two pieces bolted together, nor is such an interpretation reasonable." Appeal Brief, page 16.

Responding, the Examiner found that once the cable support is assembled and attached to the caliper housing that the two elements are interpreted as one, or one piece.

On the "one piece" issue we find ourselves between a rock and hard place. Shimano's claim uses the phrase "one piece" but the phrase is not defined in the specification. For example, the specification does not say that "one piece" means "one *integral* piece."

Shimano Figs. 4-5 and 7 show what appears to be a "one piece" (i.e., an one integral piece) element made up of elements 30 and 44. The specification says the following (col. 6:41-49) (italics added):

> As seen in FIGS. 7-12, the left caliper portion 38 basically has a body portion 42 a pair of mounting flanges 43 and a *cable support flange 44*. The body portion 42 has a pad support bore 45 extending in a longitudinal direction and an axially extending internal bore 46 that extends longitudinally between a first open end 48 and a second open end 50 of the left caliper portion 38. The pad support bore 45 is utilized to support the brake pads 32 on the caliper housing 30 as discussed below.

The specification also says (col. 7:33-37) (italics added):

> As seen in FIGS. 2, 4, 7 and 8, the *cable support member or flange 44 extends outwardly from the body portion 42* in a direction that is substantially tangent to an imaginary circle with its center located at the center axis of the internal bore 46.

On the other hand, as noted by the Examiner, when two pieces are connected so as to be immobilized one with respect to the other, we cannot

say that the two pieces—now immobilized—do not function as one piece, particularly when in combination they seem to function in the same manner as a "one integral piece" would function.

At the end of the day, since the only "one piece" element described in the specification is an integral element, we agree with Shimano that the Le Deit device does not describe a "one piece" element.

The decision of the Examiner rejecting claim 69 under § 103 is *reversed.*

Claim 72-73

The arguments with respect to claims 72-73 appear to be the same as the argument with respect to claim 37. Appeal Brief, pages 16-17.

The decision of the Examiner rejecting claims 72-73 under § 103 is *affirmed.*

Claim 74

Claim 74, like claim 69, recites a "one piece" element. *See* Appeal Brief, page 18. Were it not for the "one piece" element limitation, we would affirm. However, based solely on the "one piece" element difference, the decision of the Examiner rejecting claim 74 under § 103 is *reversed.*

Summary of disposition of prior art rejections

Apart from the claims addressed above, Shimano has not singled out any other claim for separate consideration.

The decision of the Examiner rejecting claims 37-42, 47-60 and 72-73 over the prior art is *affirmed.*

The decision of the Examiner rejecting claims 43, 69 and 74 and claims dependent therefrom (claims 70-71) over the prior art is *reversed.*

D. The "recapture" rule rejections

Claims to be considered

With respect to the recapture rule appeal, Shimano, in its Appeal Brief and Reply Brief, presents specific arguments directed only to claims 37 and 72-74. Other dependent claims are not separately argued. Hence, ordinarily we would consider *only* claims 37 and 72-74. Notwithstanding Shimano presented no separate argument with respect to claim 69, but because of our resolution of the § 103 issue of claim 69, we will consider claim 69 apart from claim 37 (from which it depends).

In effect, claim 69 stands or falls with claim 74 because both contain a "one piece" limitation. Compare the discussion of claims 44-46 *infra*, where there was no occasion to consider prior art vis-à-vis claims 44-46.

Original claim 1

Original application 09/531,570 (now U.S. Patent 6,557,671 B1), as filed, contained claims 1-13.

Original claim 1 read [drawing numbers and bracketed matter added]:

> A cable disc brake comprising:
>
> [1] a caliper housing 30 [col. 6:13-16];

[2] a first friction member 32 [Fig. 6, left side] movably coupled to said caliper housing between a release position and a braking position [col. 6:24-29];

[3] a second friction member 32 [Fig. 6, right side] coupled to said caliper housing 30 and arranged substantially parallel to said first friction member 32 [Fig. 6, left side] to form a rotor receiving slot therebetween [col. 7:62-65]; and

[4] an actuated mechanism 34, 36 [Fig. 6; col. 6:16-19] movably coupled to said caliper housing 30 to move said first friction member 32 [Fig. 6, left side] from said release position towards said second friction member 32 [Fig. 6, right side] to said braking position [col. 6:16-19] , said actuated mechanism 34, 36 having first 90 and second 91 cam members [Fig. 5, col. 8:49-52] movably arranged between an axially retracted position and an axially extended position [col. 8:53-61] with a guide member 90c [Fig. 5; col. 8:62-65] interconnecting said first 90 and second 91 cam members during movement between said axially retracted position and said axially extended position [col. 9:39-45].

First rejection

All the original claims in the original application, including original claim 1, were rejected under 35 U.S.C. § 102(b) as anticipated by Toyomasu, U.S. Patent 3,765,511. Office Action mailed 23 May 2001 (Paper 6).

First amendment

In an amendment received at the USPTO on 09 August 2001 (Paper 7, Amendment A), claim 1 was amended to read [bracketed matter added; limitations added shown in underlining]:

Claim 1 (amended). A cable disc brake comprising:

[1] a caliper housing;

[2] a first friction member movably coupled to said caliper housing between a release position and a braking position;

[3] a second friction member coupled to said caliper housing and arranged substantially parallel to said first friction member to form a rotor receiving slot therebetween; and

[4] an actuated mechanism movably coupled to said caliper housing to move said first friction member in an axial direction from said release position towards said second friction member to said braking position without rotating said first friction member [output cam 91, which moves first friction member 32 (Fig. 6, left side), is nonrotatably mounted to rotation stopper 94 (col. 9:49-53)], said actuated mechanism having first and second cam members movably arranged between an axially retracted position and an axially extended position with a guide member interconnecting said first and second cam members during movement between said axially retracted position and said axially extended position,

one 90 of said first 90 and second 91 cam members being rotatably mounted within said caliper housing 30, and the other 91 of

said first 90 and second 91 cam members being movably mounted in said axial direction [col. 9:32-37].

In remarks, Shimano said inter alia the following:

> In response, Applicant has amended independent claim 1 to clearly define the present invention over the prior art of record. Amendment, pages 4-5.
>
> In particular, independent claim 1 has been amended to recite a cable disc brake having first and second cam members with one of the first and second cam members being rotatably mounted within the caliper housing, and the other of the first and second cam members being movably mounted in the axial direction. Moreover, independent claim 1 has been amended to recite that the first friction members moves in an axial direction without rotating. Clearly, this structure is *not* disclosed or suggested by Toyomasu or any other prior art of record. More specifically, the Office Action relies on the embodiment shown in Figure 33 of Toyomasu to reject claims 1-13. However, the first and second camming [sic—cam ?] members 16 and 43 of Toyomasu do not operate in the same manner as set forth in independent claim 1, as now amended. More specifically, the *camming* [sic—cam ?] *member 16* of Toyomasu is designed to rotate and move axially while the *camming* [sic—cam member ?] *43* of Toyomasu is designed to be a *stationary member*.
>
> Accordingly, neither the camming member 16 of Toyomasu nor the camming member 43 of Toyomasu rotates but does not move

axially, or moves axially but does not rotate as now set forth in amended claim 1. Moreover, claim 1 now recites that the *first friction members moves in an axial direction but does not rotate.* In the cable brake device of Toyomasu, the friction member 6 is both *rotated* and *moved axially*. Amendment A (Paper 7), page 5.

Second rejection

After a notice of allowance, withdrawal from issue and a filing of an RCE [request for continued examination], there came a time when a second rejection was entered by the Examiner. Office Action mailed 11 July 2002 (Paper 14).

At this point, the original application contained claims 1-20.

Claims 1-20 were rejected under 35 U.S.C. § 102(b) as anticipated by Kawaguchi [U.S. Patent 3,789,959].

Second amendment

A response to the second rejection was received by the USPTO on 08 November 2002. Paper 16 (Amendment B).

In response to the second rejection, claim 1 was again amended [some bracketed matter added, limitations added by the first amendment shown in bold; limitations deleted shown in strikethrough and limitations added shown in underlining]:

Claim 1 (twice amended). A cable disc brake comprising:

[1] a caliper housing;

[2] a first friction member movably coupled to said caliper housing between a release position and a braking position;

[3] a second friction member coupled to said caliper housing and arranged substantially parallel to said first friction member to form a rotor receiving slot therebetween; and

[4] an actuated mechanism movably coupled to said caliper housing to move said first friction member in an axial direction from said release position towards said second friction member to said braking position ~~without rotating said first friction member~~, said actuated mechanism ~~having first and second cam members movably arranged between an axially retracted position and an axially extended position with a guide member interconnecting said first and second cam members during movement between said axially retracted position and said axially extended position,~~

~~one of said first and second cam members being rotatably mounted within said caliper housing, and the other of said first and second cam members being movably mounted in said axial direction~~ including

an input cam 90 [Fig. 5, col. 8:49-52] movably mounted within said caliper housing 30 to move in a rotational direction about a longitudinal axis [col. 8:56-61] , but not in an axial direction [input cam 90 is one-piece and is axially immovably fastened to caliper housing 30 via nut 97 as shown in Fig. 5], said input cam having a

first camming surface 90d [Fig. 31, col. 8:65-67] with an axially extending guide member 90c [Fig. 5; col. 8:62-65] non-movably fixed thereto at said longitudinal axis [input cam 90, including guide member 90c, is one-piece as shown in Fig. 5], and

an output cam 91 [Fig. 5; col. 8:49-52] movably mounted within said caliper housing 30 to move in the axial direction in response to rotation of said input cam 90 [col.9:33-38], but not in the rotational direction [col. 9:45-49], said output cam having a second camming surface 91c [Fig. 35; col. 9:31-33] with an axially extending bore 91e [Fig. 34; col. 9:39-42], said guide member being at least partially disposed within said bore 91e to ensure smooth relative movement between said input and output cams 90, 91 [col. 9:24-27].

In remarks, Shimano said *inter alia* the following:

> Specifically, Applicants have amended independent claim 1 to clarify that the actuated mechanism includes an input cam movably mounted within said caliper housing to move in a rotational direction about a longitudinal axis, but not in an axial direction, said input cam having a first camming surface with an axially extending guide member non-movably fixed thereto at said longitudinal axis, and an output cam movably mounted within said caliper housing to move in the axial direction in response to rotation of said input cam, but not in the rotational direction, said output cam having a second camming surface with an axially extending bore, said guide member being at

least partially disposed within said bore to ensure smooth relative movement between said input and output cams.

* * *

Applicants do not believe the unique arrangements of independent claim[ ] 1 . . . [is] disclosed or suggested in the Kawaguchi patent.

Specifically, the Kawaguchi patent basically discloses a disc brake which includes an operation lever 14 loosely mounted to the threaded tube 12 behind a plate 13. The plate 13 is a pressure receiving plate while the operation lever 14 acts to actuate the pressure receiving plate 13. Balls 16 are disposed between the plates 13 and 14. When the operation lever 14 is turned, the pressure receiving plate 13 will cause, through the action of balls 16, axial movement of threaded tube 12 and the adjusting screw 11 mounted therein, thereby urging pad 8 against the disc 2. Thus, at best, the Kawaguchi patent discloses a guide member that is axially movable with the axially movable plate 13. In other words, the Kawaguchi patent fails to disclose or suggest the axially extending guide member non-movably fixed to the input cam at the longitudinal axis, where the input cam is rotatably but not axially movable, as required by independent claim 1, as now amended. Amendment B (Paper 16), pages 7-8.

Claim 37 on appeal

Claim 37 on appeal deletes some limitations from claim 1 (twice amended—which claim 1 of the patent), but adds other limitations.

Claim 37 reads [bracketed matter added, limitations deleted shown in strikethrough and limitations added shown in bold].

> Claim 37. A cable disc brake for a bicycle comprising:
>
> a caliper housing with a mounting bracket structured and dimensioned to be attached to a bicycle with a cable support having an opening for guiding a cable there through;
>
> wherein the cable support extends from a surface of the caliper housing and is not adjustable in any direction relative to the surface of the caliper housing;
>
> a first friction member ~~movably~~ coupled to ~~said~~ the caliper housing for movement between a release position and a braking position;
>
> a second friction member coupled to ~~said~~ the caliper housing and arranged substantially parallel to ~~said~~ the first friction member to form a rotor receiving slot therebetween; and
>
> an actuated mechanism movably coupled to ~~said~~ the caliper housing to move ~~said~~ the first friction member in an axial direction from ~~said~~ the release position towards ~~said~~ the second friction member to ~~said~~ the braking position, ~~said~~
>
> wherein the actuated mechanism ~~including~~
>
> ~~an input cam movably mounted within said caliper housing to move in a rotational direction about a longitudinal axis, but not in an~~

~~axial direction, said input cam having first camming surface with an axially extending guide member non-movably fixed thereto at said longitudinal axis, and~~

~~an output cam movably mounted within said caliper housing to move in the axial direction in response to rotation of said input cam, but not in the rotational direction, said output cam having a second camming surface with an axially extending bore, said guide member being at least partially disposed within said bore to ensure smooth relative movement between said input and output cams~~ comprises an elongated actuating arm rotatably coupled to the caliper housing to cause the actuated mechanism to move the first friction member from the release position towards the braking position;

wherein the actuating arm has a curved guide surface with a first portion coincident with a cable clamp and a second portion that extends from the first portion towards the cable support so that the cable, when coupled to the cable clamp, approaches the guide surface from the opening in the cable support essentially tangent to the guide surface and is supported by the guide surface when the first friction member in the release position.

Claim 74

Claim 74 is similar in many respects to claim 37. However, one significant difference is that claim 74 contains a "one piece" limitation [drawing element numbers, italics and some discussion added]:

wherein *the cable support 44 is one piece* with the surface of the caliper housing 30 from which it extends [clearly said by Shimano to be shown in Fig. 7—see also Fig. 5]

Shimano's position

According to Shimano, claim 37 recites the following limitations:

(1) wherein the cable support extends from a surface of the caliper housing and is not adjustable in any direction relative to the surface of the caliper housing, and

(2) wherein the actuating arm has a curved guide surface with a first portion coincident with a cable clamp and a second portion that extends from the first portion towards the cable support so that the cable, when coupled to the cable clamp, approaches the guide surface from the opening in the cable support essentially tangent to the guide surface and is supported by the guide surface when the first friction member is in the release position.

Appeal Brief, pages 11-12.

Further according to Shimano, these limitations "materially narrow" claim 37 vis-à-vis patent claim 1 (which is claim 1 of the original application, twice amended). Claim 37, therefore, is said to "recite a distinct invention." Appeal Brief, page 12.

With respect to claim 74, Shimano further argues the "one piece" limitation. Appeal Brief, page 13. According to Shimano, the "one piece" "feature" causes claim 74 "to recite a distinct invention and therefore

materially narrow claim 74" avoids "the recapture rule according to step (3) [of *Clement*]. *Id.*

Examiner's findings

The Examiner correctly found that (1) the strikethrough limitations of claim 37, as reproduced above, were deleted vis-à-vis claim 1, and (2) the bold limitations were added.

The Examiner made no findings with respect to whether (1) the added bold limitations relate to an aspect of the invention *overlooked* (not claimed) during the original prosecution and, if so, (2) whether those limitations *materially* narrow claim 37 with respect to the overlooked aspect of the invention.

Legal principles

Based on *In re Clement*, 131 F.3d 1464, 1470 (Fed. Cir. 1997), the following principles apply.

Principle 1. If the reissue claim is as broad as or broader than the cancelled or amended claim in all aspects, the recapture rule bars the claim.

Principle 2. If the reissue claim is narrower than the cancelled or amended claim in all aspects, the recapture rule does not apply, but other rejections (e.g., § 102, § 103, § 112) are possible.

Principle 3: If the reissue claim is broader in some aspects, but narrower in other aspects, than the cancelled or amended claim, then:

Principle 3(a): if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection of a claim in the original application, but *narrower in another aspect completely unrelated to the rejection*, the recapture rule bars the reissue claim or

Principle 3(b): if the reissue claim is narrower in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1482-83 (Fed. Cir. 1998) (emphasis added; some citations omitted) has also established an additional principle that:

> [T]he recapture rule [may be avoided altogether] when the reissue claims are *materially* narrower in other *overlooked* aspects of the invention. The purpose of . . . [this principle] is to allow the patentee to obtain through reissue a scope of protection to which . . . [the patentee] is rightfully entitled for such overlooked aspects.

See also MPEP § 1412.02(I)(C) [8th ed., Rev. 7, July 2008].

By "other . . . aspects", *Hester* means aspects not previously claimed during prosecution of the application maturing into the patent sought to be reissued.

Accordingly, we can resolve a recapture rejection by determining whether the "narrower in another aspect" (i.e., a limitation of a reissue claims) was (1) overlooked during original prosecution *and* (2) is material.

Whether an aspect of a reissue claim was *overlooked* during original prosecution is fact-based and is resolved on a case-by-case basis.

Whether an aspect of a reissue claim is *material* is also fact-based and also resolved on a case-by-case basis.

One way to show materiality may be to show that the reissue claim is patentable over the prior art. *Ex parte Bradshaw*, 2007 WL 2139843, slip op. at 15-20 (BPAI July 19, 2007), also available at: http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&flNm=fd2006274407-19-2007-0.

Shimano's Bd. R. 41.37(d) supplemental brief

We were unable to find in the Appeal Brief a detailed factual analysis of the "overlooked" or "material" issues.

We declined to resolve either issue in the first instance without affording Shimano an opportunity to present its position on the relevant facts.

An appellant, not the Board in the first instance, should set forth the relevant facts upon which it bases its request for reversal of an examiner's rejection.

To help us resolve the "recapture" rejection of claims 37 and 72-74 on appeal, we invited Shimano to address several points, two of which were:

Point (2)

Point (2): Shimano was invited to address (1) why relevant limitations in *claims 37 and 72-74* should be considered to have been "overlooked" and (2) why those limitations are "material."

Point (3)

Point (3): Shimano was invited to state its views on what criteria should be used to determine whether a limitation is "material".

We noted that one way to show that a newly added limitation is "material" is to establish that a reissue claim containing the limitation is

patentable over the prior art. *Ex parte Bradshaw*, *supra*. There may be alternative ways. For example, in a § 135(b) context, "material" and "patentability" (*i.e.*, obviousness) do not mean the same thing. *In re Berger*, 279 F.3d 975, 981-982 (Fed. Cir. 2002).

In presenting its views, we asked Shimano to address whether a reissue claim can contain new limitation which can be considered "material" if the reissue claim does *not* define subject matter patentable over the prior art.

Shimano responded to our invitation and filed a supplemental brief. Response to Request for Additional Briefing, filed 8 May 2009.

Resolution of the recapture rule rejections

In its Response to Request for Additional Briefing, Shimano states (page 17) that the "one piece" limitation of claim 74 was not claimed during prosecution of the application maturing into the patent sought to be reissued. Shimano reasons therefore that the "one piece" limitation was "overlooked" during original prosecution.

We have reviewed the patent claims, including Shimano's annotated version of those claims as appear in the Response to Request for Additional Briefing. We have been unable to find where any "one piece" limitation was explicitly claimed during prosecution. The Examiner has not called our attention to any "one piece" limitation in any claim involved in the prosecution of the application which matured into the patent sought to be reissued.

We will note that during original prosecution, Shimano added claim 21 [drawing element numbers, italics and discussion by Shimano added]:

> 21. A cable disc brake (12a) according to claim 1, wherein said input cam (90) includes a first cam member ((90a; Fig. 29, col. 8:62-65) disposed within *an internal bore* ((46); Fig. 12, col.6:42-46) of said caliper housing (30) (as shown in Fig. 5).

For the convenience of the reader, we repeat what the specification has to say about cable support flange 44 as it relates to internal bore 46 (col. 6:41-49) (italics added):

> As seen in FIGS. 7-12, the left caliper portion 38 basically has a body portion 42 a pair of mounting flanges 43 and a *cable support flange 44*. The body portion 42 has a pad support bore 45 extending in a longitudinal direction and an axially extending internal bore 46 that extends longitudinally between a first open end 48 and a second open end 50 of the left caliper portion 38. The pad support bore 45 is utilized to support the brake pads 32 on the caliper housing 30 as discussed below.

The specification also says (col. 7:33-37) (italics added):

> As seen in FIGS. 2, 4, 7 and 8, the *cable support member or flange 44 extends outwardly from the body portion 42* in a direction that is substantially tangent to an imaginary circle with its center located at the center axis of the internal bore 46.

The fact that an internal bore 46 was claimed in the original patent (claim 21) does not establish that Shimano did not overlook the "one piece" feature of its invention. The internal bore 46 is not dependent on a "one piece" element and vice-versa.

On the record before us, we hold that the "one piece" element is material within the meaning of *Hester* because it renders claim 74 patentable over the prior art. *Ex parte Bradshaw*, *supra*.

On the record before us, we further hold that the "one piece" element was overlooked within the meaning of *Hester* because it was not claimed during prosecution of the application which matured into the patent sought to be reissued.

On the record before us, we still further hold that, in view of the resolution of the § 103 rejections, the new limitations in claims 37 and 72-73 are not material within the meaning of *Hester*, because claims 37 and 72-73 are not patentable over the prior art.

The decision of the Examiner rejecting claims 69-71 and 74 based on the recapture rule is *reversed*.

The decision of the Examiner rejecting claims 37 and 72-73 (and claims 38-60 depending directly or indirectly from claim 37 and not separately argued in the Appeal Brief and Reply Brief with respect to the recapture rule rejection) based on the recapture rule is *affirmed*.

Claims 44-46

In presenting the appeal via the Appeal Brief and Reply Brief, Shimano did not separately address claims 44-46 with respect to the recapture rule—despite the known fact that those claims were not rejected over the prior art.

For this reason, Shimano should not be surprised that the Examiner likewise did not have to, and did not, separately address claims 44-46 with respect to the recapture rule rejection.

In inviting Shimano to comment on the overlooked aspects of claims 37 and 72-74, we said:

> Point (2)
>
> Shimano should address (1) why relevant limitations in claims 37 and 72-74 should be considered to have been "overlooked" and (2) why those limitations are "material."

We limited the claims to be discussed to claims 37 and 72-74 because with respect to the recapture rule those were the only claims specifically addressed in the Appeal Brief and Reply Brief.

The request for supplemental briefing was not intended to reopen prosecution or to permit Shimano to address additional claims beyond claims 37 and 72-74.

Despite the narrow request, in its response Shimano separately addresses for the first time claim 44 and claims 45-46 which depend from claim 44. *See* Response to Request for Additional Briefing, page 8:

> Claim 44 . . . [is] reproduced because claim 44 and dependent claims 45-46 were not rejected over the prior art.

and page 17:

> Pursuant to Point (1)(2), Shimano reproduced claim 44. The limitations in claim 44 believed to be overlooked include the text
>
> > "wherein the biasing mechanism comprising a spring having a first end and a second end, and wherein the adjusting mechanism adjusts the biasing force by moving

one of the first end and the second end relative to the other one of the first end and the second end."

These aspects are believed to have been overlooked because they were not previously claimed in conjunction with the limitations of claim 37 during prosecution of the application maturing into the patent sought to be reissued.

We decline to consider the argument or to address claims 44-46 separately. *First*, the argument was not presented in the Appeal Brief and therefore was waived. *Second*, the argument was not presented in the Reply Brief. *Third*, discussion of claims 44-46 was not authorized in our Bd. R. 41.37(d) order. *Fourth*, the Examiner has not had an opportunity to address the arguments. *Fifth*, a remand to the Examiner is not in order because Shimano could have presented the arguments in the Appeal Brief for consideration in the first instance by the Examiner. The rules give an applicant an opportunity to argue in the Appeal Brief each claim the applicant wants the Board to separately consider. Shimano did not timely avail itself of the opportunity provided by the rules. Accordingly, on this record, Shimano has waived it right to have claims 44-46 considered separately with respect to the recapture rule rejection. The recapture rule rejection of claims 44-46 therefore stands or falls with the recapture rule rejection of claim 37.

E. Decision

Upon consideration of the appeal, and for the reasons given herein, it is

ORDERED that the decision of the Examiner rejecting claims 43, 69-71 and 74 over the prior art is *reversed*.

FURTHER ORDERED that the decision of the Examiner rejecting claims 37-42, 47-60 and 72-73 over the prior art is *affirmed*.

FURTHER ORDERED that the decision of the Examiner rejecting claims 69-71 and 74 based on the recapture rule is *reversed*.

FURTHER ORDERED that the decision of the Examiner rejecting claims 37-60 and 72-73 based on the recapture rule is *affirmed*.

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2008).

AFFIRMED-IN-PART and REVERSED-IN-PART

saw

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Appendix 1

Status of Claims

Claim	Allowed	Rejected	Rejected	Rejected	Rejected
		Recapture	Le Deit	Le Deit	Le Deit
			Carre	Carre	Carre
			Huang	Huang	Huang
				Isai	Isai
					Mott
1	x				
2	x				
3	x				
4	x				
5	x				
6	x				
7	x				
8	x				
9	x				
10	x				
11	x				
12	x				
13	x				
14	x				
15	x				
16	x				
17	x				
18	x				
19	x				
20	x				
21	x				
22	x				
23	x				
24	x				

Claim	Allowed	Rejected	Rejected	Rejected	Rejected
		Recapture	Le Deit	Le Deit	Le Deit
			Carre	Carre	Carre
			Huang	Huang	Huang
				Isai	Isai
					Mott
25	x				
26	x				
27	x				
28	x				
29	x				
30	x				
31	x				
32	x				
33	x				
34	x				
35	x				
36	x				
37		x	x		
38		x	x		
39		x	x		
40		x	x		
41		x	x		
42		x	x		
43		x	x		
44		x			
45		x			
46		x			
47		x	x		
48		x	x		
49		x	x		

1

1

Claim	Allowed	Rejected	Rejected	Rejected	Rejected
		Recapture	Le Deit	Le Deit	Le Deit
			Carre	Carre	Carre
			Huang	Huang	Huang
				Isai	Isai
					Mott
50		x	x		
51		x	x		
52		x	x		
53		x	x		
54		x	x		
55		x		x	
56		x		x	
57		x		x	
58		x		x	
59		x		x	
60		x			x
61	x				
62	Cancelled				
63	x				
64	x				
65	x				
66	Cancelled				
67	x				
68	x				
69		x	x		
70		x	x		
71		x	x		
72		x	x		
73		x	x		
74		x	x		

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